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09/895,894	06/29/2001	Manoel Tenorio	020431.0848	7075

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EXAMINER

CHEUNG, MARY DA ZHI WANG

ART UNIT PAPER NUMBER

3621

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/895,894

Applicant(s)

TENORIO, MANOEL

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the amendment filed on July 12, 2004. Claims 1-34 are pending. No claim is added, canceled or amended.

### ***Response to Arguments***

2. Applicant's arguments filed July 12, 2004 have been fully considered but they are not persuasive.

In response to the applicant's arguments about the 112 2<sup>nd</sup> paragraph rejection, examiner believes that the rejection is proper because the phrase "not substantially affecting" is indeed indefinite.

The applicant argues that Ogilvie (U. S. Patent 6,343,738) fails to teach generate for creating a particular pattern in data associated with one or more products and is applied to the data associated with the one or more product because the sample in Ogilvie's teaching does not exist until after the sampling techniques are applied to the digital goods. Examiner disagrees because the sample data referred by examiner is the data that used for sampling, which is originally existed within the digital goods prior to the sampling techniques. The sampling technique in Ogilvie's teaching corresponds to the limitation "creating a particular pattern". The sampling technique is associated with the data used for sampling.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the case of combining Ogilvie and Walker (U. S. Patent 6,249,772), although Ogilvie does not specifically teach searching capability for data, the search capability for data is taught by Walker and such capability is widely used and well known in the art for internet purchase. In the case of Ogilvie and Walker combining with Kuo (U. S. Patent 6,230,288), the non-printable ASCII characters is taught by Kuo, and such technology is generally available to one of ordinary skill in the art.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claims 1, 11, 21 and 31-34, the phrase "not substantially affecting" renders the claim indefinite because it is unclear how exactly the authorized use of data are not being affected.

The dependent claims 2-10, 12-20 and 22-30 are rejected for incorporating the errors of their respective base claims by dependency.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 8, 11-15, 18, 21-25, 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738, in view of Walker et al, U. S. Patent 6,249,772.

As to claims 1, 11, 21 and 31, Ogilvie teaches a system, a method and software for watermarking data associated with one or more products, comprising (column 18 lines 55-56 and column 19 lines 55-56 and column 20 lines 53-56 and Figs. 9-10; *specifically, "one or more products" corresponds to the digital goods, and "data" corresponds to the sample in Ogilvie's teaching*):

a) Generate an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers (column 13 lines 45-46 and column 20 lines 8-23 and column 21 line 45 – column 22 line 9 and Fig. 6; *specifically, deleting every Nth character in Ogilvie's teaching is an example of "a particular pattern"*), the data being stored in one or more databases accessible to one or more buyer computers (Figs. 11-12), the pattern facilitating identification of a copy of the data and not substantially affecting authorized use of the data by the one or more buyer computers or users associated with the buyers computers (column 20 line 65 – column 21 line 40);

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- b) Apply the algorithm to the data to create the particular pattern in the data (column 20 lines 8-23 and column 21 line 45 – column 22 line 9).

Ogilvie does not explicitly teach the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products. However, Walker teaches buyers search queries among databases for data associated with certain of the products (column 9 line 57 – column 10 line 10 and Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data stored in one or more databases in Ogilvie's teaching to be searched as taught by Walker because this would allow buyers quickly and easily search desired information.

As to claims 2, 12 and 22, Ogilvie teaches data are stored in one or more databases as discussed above. Ogilvie does not explicitly teach the one or more databases comprise seller databases associated with a particular seller. However, Walker teaches this matter (Figs. 2-3, 5-6B). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the one or more databases in Ogilvie's teaching to include seller databases associated with a particular seller as taught by Walker because this would allow the broker to easily and accurately monitoring transactions.

As to claims 3, 13 and 23, Ogilvie teaches data are stored in one or more databases as discussed above. Ogilvie does not explicitly teach the one or more databases comprise a shared data repository. However, Walker teaches this matter (Figs. 2-3). It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to allow the one or more databases in Ogilvie's teaching to include a shared data repository as taught by Walker because this would allow the broker to easily collecting and organizing both buyers information and sellers information.

As to claims 4, 14 and 24, Ogilvie teaches data associated with one or more products as discussed above. Ogilvie does not specifically teach the data comprises one or more product attribute values, seller attribute values, and product descriptions for each of the one or more products. However, Walker teaches data associated with one or more products comprises one or more product attribute values (*i.e. model number in Fig. 6A*), seller attributes values (*i.e. seller's price in Fig. 6A*), and product descriptions (*i.e. item description in Fig. 6A*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data in Ogilvie's teaching to include product attribute values, seller attribute values, and product descriptions because this would allow the buyers to better determine if certain products meet their needs.

As to claims 5, 15 and 25, Ogilvie teaches the algorithm is a sifting function (column 20 lines 8-23 and column 21 line 45 – column 22 line 9; *specifically, deleting every Nth character in Ogilvie's teaching is an example of "a sifting function"*).

As to claims 8, 18 and 28, Ogilvie teaches the pattern comprises a plurality of insertion, deletion, or modifications of printable ASCII characters in data according to a predefined arrangement (column 20 lines 8-23 and column 21 line 45 – column 22 line 9)

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7. Claims 6-7, 16-17 and 26-27 and 32-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738, U. S. Patent 6,343,738 in view of Walker et al, U. S. Patent 6,249,772 in further view of Kuo et al., U. S. Patent 6,230,288.

As to claims 6-7, 16-17 and 26-27, Ogilvie modified by Walker further teaches the pattern comprises a plurality of ASCII characters inserted throughout the data according to a predefined arrangement; and a particular set of ASCII characters appearing after each instance of a particular group of characters in the data (Ogilvie: column 20 lines 8-23 and column 21 line 45 – column 22 line 9). Ogilvie modified by Walker does not specifically teach the ASCII characters are non-printable. However, Kuo teaches inserting non-printable ASCII characters into a file (column 5 lines 5-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the ASCII characters in the teaching of Ogilvie modified by Walker to be non-printable ASCII characters because this would provide sellers more choices with additional various patterns that can be added to the data so that the sellers' products can be better protected.

As to claims 32-34, Ogilvie teaches a system, a method and software for watermarking data associated with one or more products, comprising (column 18 lines 55-56 and column 19 lines 55-56 and column 20 lines 53-56 and Figs. 9-10; *specifically, "one or more products" corresponds to the digital goods, and "data" corresponds to the sample in Ogilvie's teaching*):



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- c) Generate an algorithm for creating a particular pattern in data associated with one or more products available from one or more sellers (column 13 lines 45-46 and column 20 lines 8-23 and column 21 line 45 – column 22 line 9 and Fig. 6; *specifically, deleting every Nth character in Ogilvie's teaching is an example of "a particular pattern"*), the data being stored in one or more databases accessible to one or more buyer computers (Figs. 11-12), the pattern comprising a plurality of ASCII characters inserted throughout the data according to a pre-defined arrangement (column 20 lines 8-23 and column 21 line 45 – column 22 line 9), the pattern facilitating identification of a copy of the data and not substantially affecting authorized use of the data by the one or more buyer computers or users associated with the buyers computers (column 20 line 65 – column 21 line 40);
- d) Apply the algorithm to the data to create the particular pattern in the data (column 20 lines 8-23 and column 21 line 45 – column 22 line 9).

Ogilvie does not explicitly teach the data being stored in one or more databases accessible to one or more buyer computers for search queries for data associated with certain of the products. However, Walker teaches buyers search queries among databases for data associated with certain of the products (column 9 line 57 – column 10 line 10 and Figs. 1-2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data stored in one or more databases in Ogilvie's teaching to be searched as taught by Walker because this would allow buyers quickly and easily search desired information.

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Ogilvie does not specifically teach the data comprises one or more product attribute values, seller attribute values, and product descriptions for each of the one or more products. However, Walker teaches data associated with one or more products comprises one or more product attribute values (*i.e. model number in Fig. 6A*), seller attributes values (*i.e. seller's price in Fig. 6A*), and product descriptions (*i.e. item description in Fig. 6A*). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the data in Ogilvie's teaching to further include product attribute values, seller attribute values, and product descriptions because this would allow the buyers to better determine if certain products meet their needs.

Ogilvie modified by Walker does not specifically teach the ASCII characters are non-printable. However, Kuo teaches inserting non-printable ASCII characters into a file (column 5 lines 5-25). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the ASCII characters in the teaching of Ogilvie modified by Walker to be non-printable ASCII characters because this would provide sellers more choices with additional various patterns that can be added to the data so that the sellers' products can be better protected.

8. Claims 9, 19 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738, U. S. Patent 6,343,738 in view of Walker et al, U. S. Patent 6,249,772 in further view of Berkland et al., U. S. Patent 4,648,047.

As to claims 9, 19 and 29, Ogilvie modified by Walker teaches applying a particular pattern in the data as discussed above. Ogilvie modified by Walker does not specifically teach the pattern comprises each instance of a particular group of

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characters in the data being underscored throughout the data. However, Berkland teaches inserting underscore function into a file (column 10 lines 17-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the particular group of characters in the teaching of Ogilvie modified by Walker to be underscored throughout the data because this would provide sellers more choices with additional various patterns that can be added to the data so that the sellers' products can be better protected.

9. Claims 10, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie, U. S. Patent 6,343,738, U. S. Patent 6,343,738 in view of Walker et al, U. S. Patent 6,249,772 in further view of Astola et al., U. S. Patent 6,094,722.

As to claims 10, 20 and 30, Ogilvie modified by Walker further teaches using checksum technique for granting permission usages of the data (Ogilvie: column 20 lines 31-40). Ogilvie modified by Walker does not specifically teach determining a first sum of numerical values of bytes representing the data stored in the one or more databases for later comparison with a second sum of numerical values of bytes representing data from another source to determine whether the data from the other source is a copy of the data from the one or more databases. However, this matter is taught by Astola as determining whether a file is original by comparing the sum of numerical byte values of the file with the checksum of the original data (column 1 lines 45-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teaching of Ogilvie modified by Walker to include the feature of determining whether a data is original by comparing the sum of numerical

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byte values of the data with the checksum of the original data because this would allow duplicated data to be quickly and easily detected so that the sellers' products can be better protected.

### ***Conclusion***

10. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

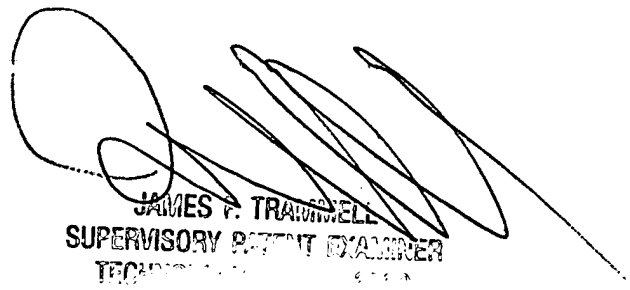
The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final  
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
October 7, 2004

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNICAL